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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,522	12/27/2001	Yoshihisa Yamashita	2001_1854A	9418

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER
ZARNEKE, DAVID A

ART UNIT	PAPER NUMBER
2827	

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,522	YAMASHITA ET AL.	
	Examiner	Art Unit	
	David A. Zarneke	2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) *9-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 April 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 1-8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-36 are withdrawn from examination as claims non-elected without traverse.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,570,099 (hereafter '099). Although the conflicting claims are not identical, they are not patentably distinct from each other because '099 claims the use of 2 electrical insulators

as opposed to 1 thermally conductive conductive resin sheet. Both are claimed as being made of the same materials in the same percentages. The use of 2 insulators as opposed to 1 is unpatentable because the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In re Harza, 124 USPQ 378 (CCPA 1960).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,548,152 (hereafter '152). Although the conflicting claims are not identical, they are not patentably distinct from each other because '152 claims the same composition, the only difference being the present claims require a semi-cured state. The forming of the thermally conductive substrate in a semi-cured state is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,522,555 (hereafter '555). Although the conflicting claims are not identical, they are not patentably distinct from each other because '555 claims the inclusion of a heat sink. A heart sink is a conventionally known in the art component used to remove heat from a semiconductive device. The use of conventional materials to perform there known functions in a conventional process is obvious. In re Raner 134 USPQ 343 (CCPA 1962).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-18 of U.S. Patent No. 6,329,045 (hereafter '045). Although the conflicting claims are not identical, they are not patentably distinct from each other because while '045 claims the thermosetting resin composition to be in a crushed state and the present claims are silent regarding the state of the thermally conductive resin sheet, the resin sheet of the present claims do not exclude this possibility. Particularly considering the use of comprising language in the claims. The use of crushed resin particles is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,060,150 (hereafter '150). Although the conflicting claims are not identical, they are not patentably distinct from each other because while '150 claims the inclusion of two thermosetting resins, a hardener and a hardening accelerator in the resin composition, the resin sheet of the present claims do not exclude this possibility. Particularly considering the use of comprising language in the claims. The inclusion of more starting materials is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 52-63 of

copending Application No. 10/313,534. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the copending application includes a second leadframe (wiring pattern) and a definite coefficient of thermal expansion and thermal conductivity, the present claims do not exclude this possibility. Particularly considering the use of comprising language in the claims. The inclusion of more starting materials is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-23 of copending Application No. 09/956,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the copending application includes a thermal radiation board and a definite warping degree of the thermal conductive substrate with respect to the thermal radiation member, the present claims do not exclude this possibility. Particularly considering the use of comprising language in the claims. The inclusion of more starting materials is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Zarneke whose telephone number is (703)-305-3926. The examiner can normally be reached on M-F 10AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (703)-308-1233. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

David A. Zarneke
August 31, 2003